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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,276	06/12/2006	Masayoshi Son	.285301US2XPCT	5677

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

LAEKEMARIAM, YOSEF K

ART UNIT	PAPER NUMBER
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4181

NOTIFICATION DATE	DELIVERY MODE
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02/21/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/566,276	Applicant(s) SON, MASAYOSHI	
	Examiner YOSEF K. LAEKEMARIAM	Art Unit 4181	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/30/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-13 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Forte et al. (US 7,162,020) in view of Lamb et al. (US 6,747,970).

Regarding claim 1, Forte discloses a gateway device to be installed between a public telephone network and a private branch exchange (**abstract lines 3-6**), comprising: a public telephone network connection unit (**Col.12 lines 10-16; Forte discusses network switching device, therefore network connection unit**) operable to connect said private branch exchange to said public telephone network (**abstract lines 3-10 and Col.12 lines 7-17**); an Internet connection unit operable to connect said private branch exchange to the Internet (**abstract lines 3-6 and Col.2 lines 58-66; Forte discusses a wireless connect unit which connect PBX to PSTN, therefore an internet connection unit**); a connection switching unit operable to selectively connect either said public telephone network or the Internet to said private branch exchange (**Col.4 lines 21-31 and Col.12 lines 11-21; Forte discusses network switching device and suitable communication line, therefore connection switching unit**); a detecting unit operable to detect the use condition of a communication line connected to said private branch exchange (**Col.6 lines 49-63, Col.7 lines 3-20 and Col.8 lines 54-60; Forte discusses WC 230, therefore a detecting unit**);

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Forte discloses the invention set forth above except for the claimed “a notification unit operable to notify said public telephone network that only calling is viable to said public telephone network in the case where the communication line connected to said private branch exchange is in use”.

Lamb teaches that it is well known to have wherein a notification unit **(Col.4 lines 7-16; Lamb discusses telecommunications network server, therefore a notification unit)** operable to notify said public telephone network that only calling is viable to said public telephone network in the case where the communication line connected to said private branch exchange is in use **(Col.14 lines 7-37)**.

It would have been obvious to one skilled in the art at the time the invention was made to modify the invention of Forte, and modify a notification unit operable to notify said public telephone network that only calling is viable to said public telephone network in the case where the communication line connected to said private branch exchange is in use, as taught by Lamb, thus allowing more efficient notification unit to notify public telephone network, as discussed by Lamb **(Col.14 lines 7-37)**.

Regarding claim 6, Forte discloses a private branch exchange system operable to switchingly connect between a public telephone network and an extension telephone **(abstract lines 3-12, Col.4 lines 1-11 and Fig.1, 12a, 12b, 16)**, comprising: a public telephone network connection unit **(Fig.1; 34, 36, 54)** operable to connect said extension telephone to said public telephone network **(Col.4 lines 17-28 and Col.6 lines 16-35; Forte discusses office extension numbers, therefore extension telephone)**; an Internet connection unit **(Fig.3, 14)** operable to connect said extension telephone to the Internet **(Col.4 lines 21-29 and Fig.3 12a, 12b, and 50)**; a connection switching unit **(Col.6 lines**

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48-53 and Fig.3, 229) operable to selectively connect either said public telephone network or the Internet (**Fig.3 16, 50 and 230**) to said extension telephone (**Col.4 lines 1-5 and Fig.3 12a, 12b, 16, 50**); a detecting unit (**Col.8 lines 46-59; Forte discusses WC 230, therefore a detecting unit**) operable to detect the use condition of a communication line connected to said extension telephone (**Col.8 lines 54-65; Forte discusses line port detecting activity of a call, therefore detecting use condition of a line**);

Forte discloses the invention set forth above except for the claimed “a notification unit operable to notify said public telephone network that only calling is viable to said public telephone network in the case where the communication line connected to said extension telephone is in use”.

Lamb teaches that it is well known to have wherein a notification unit (**Col.4 lines 7-16; Lamb discusses telecommunications network server, therefore a notification unit**) operable to notify said public telephone network that only calling is viable to said public telephone network in the case where the communication line connected to said extension telephone is in use (**Col.14 lines 7-37**).

It would have been obvious to one skilled in the art at the time the invention was made to modify the invention of Forte, and modify a notification unit operable to notify said public telephone network that only calling is viable to said public telephone network in the case where the communication line connected to said extension telephone is in use, as taught by Lamb, thus allowing more efficient notification unit to notify public telephone network, as discussed by Lamb (**Col.14 lines 7-37**).

Regarding claim 11, Forte discloses an extension telephone switching method of switchingly connecting between a public telephone network and an extension telephone

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(abstract lines 3-12, Col.4 lines 1-11 and Fig.1, 12a, 12b, 16), comprising: a step of selectively connecting either said public telephone network or the Internet to said extension telephone (Col.6 lines 16-35; Forte discusses office extension numbers, therefore extension telephone); a step of detecting the use condition of a communication line connected to said extension telephone (Col.8 lines 54-65;Forte discusses line port detecting activity of a call, therefore detecting use condition of a line);

Forte discloses the invention set forth above except for the claimed “a step of notifying said public telephone network that only calling is viable to said public telephone network in the case where the communication line connected to said extension telephone is in use”.

Lamb teaches that it is well known to have wherein a step of notifying said public telephone network that only calling is viable to said public telephone network in the case where the communication line connected to said extension telephone is in use **(Col.14 lines 7-37).**

It would have been obvious to one skilled in the art at the time the invention was made to modify the invention of Forte, and modify a step of notifying said public telephone network that only calling is viable to said public telephone network in the case where the communication line connected to said extension telephone is in use, as taught by Lamb, thus allowing more efficient step of notifying public telephone network, as discussed by Lamb **(Col.14 lines 7-37).**

Consider claims 2 and 7, Forte and Lamb together discloses the apparatus and system as defined in claim 1 and 6, Lamb further discusses a system wherein said

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notification unit (**Col.14 lines 7-16; Lamb discusses server detect incoming calls to notify the communications server, therefore notification unit**) notifies said public telephone network that an outgoing call process and an incoming call process are viable when the communication line connected to said private branch exchange comes to be in an unused state (**Col.14 lines 7-33**).

Consider claim 3, Forte and Lamb together discloses the gateway device as claimed in claim 1, Lamb further discloses a device wherein there are a plurality of units each of which serves as said public telephone network connection unit (**Col.14 lines 7-29 and Fig.3; Lamb discusses network server and hosting server, therefore network connection unit**) and wherein, when the communication line connected to said private branch exchange of one of the public telephone network connection units is in use in accordance with said notification (**Col.6 lines 54-63 and Col.14 lines 7-25**), another public telephone network connection unit serves to make a connection by proxy in response to a connection request issued for said one of the public telephone network connection units (**Col.46 lines 18-30**).

Consider claims 4 and 9, Forte and Lamb together discloses the gateway device as claimed in claim 1, Forte further discloses a system identifier generation unit operable to generate a caller identifier for identifying an extension telephone (**Col.7 lines 3-8; Forte discusses ANI, therefore caller identifier**) connected to said private branch exchange (**Fig.3 14**) on the basis of a control signal from the extension telephone (**Col.7 lines 3-14; Forte discusses gust room extension, therefore extension telephone**), and an intended recipient identifier for identifying a communication device of the intended recipient of the extension telephone (**Col.7 lines 23-32; Forter discusses database maintains**

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information concerning telephone extension, therefore recipient identifier); a conversion unit operable to perform conversion between voice signals and packet signals relating to the communication for voice conversation (Col.11 lines 60-67 and Col.12 lines 1-10); and a packet transmitter receiver unit operable to transmit said packet signals to and receive said packet signals from the Internet on the basis of said caller identifier and said intended recipient identifier (Col.4 lines 61-67 and Col.5 lines 1-10).

Consider claims 5 and 10, Forte and Lamb together discloses the gateway device as claimed in claim 4, Lamb further discloses a system wherein determination unit operable in order that said voice signals are output to said public telephone network without conversion into packet signals depending upon said intended recipient identifier **(Col.13 lines 15-55).**

Consider claim 8, Forte and Lamb together discloses the private branch exchange system as claimed in claim 6, Lamb further teaches a system wherein there are a plurality of units each of which serves as said public telephone network connection unit **(Col.3 lines 24-34)** and wherein, when the communication line connected to said extension telephone of one of the public telephone network connection units is in use, **(Col.1 lines 35-50)** in accordance with said notification, another public telephone network connection unit serves to make a connection by proxy in response to a connection request issued for said one of the public telephone network connection units **(Col.46 lines 18-30 and Col.64 lines 39-47).**

Consider claim 12, Forte and Lamb together discloses the extension telephone switching method as claimed in claim 11, Lamb further teaches a method comprising a step of notifying **(Col.14 lines 7-16)** said public telephone network that an outgoing call

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process and an incoming call process are viable when the communication line connected to said extension telephone comes to be in an unused state **(Col.14 lines 7-33)**.

Consider claim 13, Forte and Lamb together discloses the extension telephone switching method as claimed in claim 11, Lamb Further teaches a method wherein there are a plurality of units each of which serves as said public telephone network connection unit **(Col.14 lines 7-29 and Fig.3; Lamb discusses network server and hosting server, therefore network connection unit)**, and further comprising a step of making a proxy connection, when the communication line connected to said private branch exchange of one of the public telephone network connection units is in use, by another public telephone network connection unit serves in response to a connection request issued for said one of the public telephone network connection units in accordance with the notification **(Col.64 lines 23-47)**.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOSEF k. LAEKEMARIAM whose telephone number is (571)270-5149. The examiner can normally be reached on Regular hours 8:30am-5pm M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yosef k Lackemariam/
Examiner, Art Unit 4181
02-07-2008

/Nick Corsaro/
Supervisory Patent Examiner, Art Unit 4181